

REMARKS

Applicants note the filing of two Supplemental Information Disclosure Statements herein on August 9, 2002 and December 8, 2003 and note that no copies of the PTO-1449s were returned with the outstanding Office Action. Applicants respectfully request that the information cited on the PTO-1449s be made of record herein. Applicants have enclosed copies of the August 9, 2002 and December 8, 2003 Supplement Information Disclosure Statements, Form PTO-1449s, and USPTO date-stamped postcards evidencing receipt of the same by the USPTO, and request that copies of the Form PTO-1449s as initialed by Examiner be returned to Applicants' attorney.

In the Office Action mailed from the United States Patent and Trademark Office on April 22, 2004, the Examiner objected to the specification under 35 U.S.C. 132 and under 35 U.S.C. 112, first paragraph. In the Office Action, the Examiner also rejected claims 23-73 under 35 U.S.C. 112, first paragraph, and under 35 U.S.C. 112, second paragraph; rejected claims 23, 24, 30-32, 42, and 59 under 35 U.S.C. 102(b) as being anticipated by Rosso (United States Patent No. 5,207,234, hereinafter "Rosso"); rejected claims 43-51 under 35 U.S.C. 102(b) as being anticipated by Tasedan (United States Patent No. 4,333,277, hereinafter "Tasedan"); rejected claims 25-28 and 60-70 under 35 U.S.C. 103(a) as being unpatentable over Rosso in view of Mehta (United States Patent No. 3,543,444, hereinafter "Mehta"); rejected claims 29 and 33-41 under 35 U.S.C. 103(a) as being unpatentable over Rosso in view of Parker (United States Patent No. 5,542,999, hereinafter "Parker"); rejected claims 52-58 under 35 U.S.C. 103(a) as being unpatentable over Rosso; and rejected claims 71-73 under 35 U.S.C. 103(a) as being unpatentable over Molinari (United States Patent No. 5,037,432, hereinafter "Molinari")

in view of Spagnolo (United States Patent No. 2,238,541, hereinafter "Spagnolo"). The Examiner further rejected claims 23-73 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of United States Patent No. 6,582,442. Accordingly, Applicants respectfully provide the following:

Objection under 35 U.S.C. § 132

In the Office Action, the Examiner objected to the amendment filed 11 December 2003 under 35 U.S.C. 132 indicating that it introduced new matter into the disclosure. In particular, the Examiner indicated Applicants appear to be claiming a combination of a dermal abrasion device and massage apparatus in the same embodiment, however, there is no such combination disclosed. Applicants express appreciation for the telephonic Examiner's Interview conducted on October 20, 2004, which was conducted to clarify from the original disclosure that the present application teaches a dermabrasion and massage apparatus that controls two separate delivery devices using a single vacuum generator. For example, the application as originally filed teaches:

In yet another embodiment of the present invention, a combined massage and dermabrasion unit are described that utilize the massage system as well as the dermabrasion system of above in a convenient to use system that utilize a common vacuum supply. Both the massage system and the dermabrasion system may be used in the same treatment session. The use of both systems in the same treatment session leads to a more rapid healing and rejuvenation of a patient's skin surface as the massage action encourages blood flow to the skin surface. (see page 8, line 35 through page 9, line 5)

Another reference in the application as originally filed of a dermabrasion and massage apparatus that controls two separate delivery devices using a single vacuum generator is located on page 16, lines 16-21, which provides:

Vacuum generator 112 also may be optionally coupled or decoupled from the remaining elements of the dermabrasion apparatus 110

and is not intended to be limited to only those dermabrasion systems that include self-contained pneumatic delivery systems. Further, since the dermabrasion apparatus 110 can utilize the vacuum generator 112 as disclosed in the cited patent application, it is possible to have both a dermabrasion apparatus and a massage or body contouring system.

Applicants respectfully submit that the objection made by the Examiner under 35 U.S.C. 132 is overcome since the matter was not newly introduced, but instead was supported by the disclosure of the application as originally filed. Accordingly, Applicants respectfully request that the objection made by the Examiner under 35 U.S.C. 132 be withdrawn.

Objection under 35 U.S.C. § 112, first paragraph

In the Office Action, the Examiner objected to the specification under 35 U.S.C. 112, first paragraph, indicating that the specification as originally filed does not provide support for the invention as is now claimed. Applicants respectfully submit that the objection made by the Examiner under 35 U.S.C. 112, first paragraph, is overcome for at least the reasons provided above in association with the objection made under 35 U.S.C. § 132 and for the amendments provided herein to the claim set. Accordingly, Applicants respectfully request that the objection made by the Examiner under 35 U.S.C. 112, first paragraph, be withdrawn.

Rejection under 35 U.S.C. § 112, first paragraph

In the Office Action, the Examiner rejected claims 23-73 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not adequately described as set forth in the objection to the specification under 35 U.S.C. 112, first paragraph. Applicants respectfully submit that the rejections made by the Examiner of the claims under 35 U.S.C. 112, first paragraph, are overcome for at least the reasons provided above in

association with the objection made under 35 U.S.C. § 132 and for the amendments provided herein to the claim set. Accordingly, Applicants respectfully request that the rejections made by the Examiner under 35 U.S.C. 112, first paragraph, be withdrawn.

Rejection under 35 U.S.C. § 112, second paragraph

In the Office Action, the Examiner rejected claims 23-73 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully submit that the amendments made to the claim set as provided herein overcome the rejections made to the claim set under 35 U.S.C. 112, second paragraph. Accordingly, Applicants respectfully request that the rejections made by the Examiner under 35 U.S.C. 112, second paragraph, be withdrawn.

Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 23, 24, 30-32, 42, and 59 under 35 U.S.C. 102(b) as being anticipated by Rosso, and rejected claims 43-51 under 35 U.S.C. 102(b) as being anticipated by Tasedan. Applicants respectfully submit that the claim set as provided herein is not anticipated by the cited references, and provide the following:

The standard for a Section 102 rejection is set forth in M.P.E.P 706.02, which provides:

“... for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.”

Applicants respectfully submit that the cited references do not teach every aspect of the amended claim set as provided herein, either explicitly or impliedly, and therefore

do not anticipate the claims of the present invention. In particular, each independent claim as provided herein includes limitations relating to a single vacuum generator that is coupled to a massage head and to a dermabrasion hand piece. Such limitations are supported by the specification as originally filed as referenced above.

Applicants respectfully submit that the cited references do not teach or suggest a massage and dermabrasion apparatus that includes a single vacuum generator that is coupled to a massage head and to a dermabrasion hand piece as recited herein in the independent claims of the present claim set. In addition, the dependent claims further distinguish the present invention from the cited references. Accordingly, Applicant respectfully submits that the cited references do not teach every aspect of the claims as provided herein and therefore do not anticipate the claims as provided herein. For at least these reasons, rejection of the claims under 35 U.S.C. § 102 is respectfully requested to be withdrawn.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 25-28 and 60-70 under 35 U.S.C. 103(a) as being unpatentable over Rosso in view of Mehta, rejected claims 29 and 33-41 under 35 U.S.C. 103(a) as being unpatentable over Rosso in view of Parker, rejected claims 52-58 under 35 U.S.C. 103(a) as being unpatentable over Rosso, and rejected claims 71-73 under 35 U.S.C. 103(a) as being unpatentable over Molinari in view of Spagnolo. Applicants respectfully submit that the claim set as provided herein is not made obvious by the cited references, and provide the following:.

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicants respectfully submit that the references cited by the Examiner do not teach or suggest the limitations claimed in the present invention. In particular, each of the independent claims as provided herein includes limitations relating to a single vacuum generator that is coupled to a massage head and to a dermabrasion hand piece. Such limitations are supported by the specification as originally filed as referenced above. In contrast, none of the references cited by the Examiner, alone or in combination, teaches or suggests such limitations.

Accordingly, Applicant respectfully submits that for at least the reasons provided herein, the references cited by the Examiner, alone or in combination, do not teach or suggest all the claim limitations. And, since the references cited by the Examiner do not teach or suggest each and every limitation of the independent claims, Applicant respectfully submits that the prior art references do not make obvious the independent claims as provided herein. And, since the prior art references do not make obvious the independent claims, Applicant respectfully submits that the prior art references cited by the Examiner do not make obvious the corresponding dependent claims. For at least these reasons, rejection of the claims under 35 U.S.C. § 103 is respectfully requested to be withdrawn.

Rejections under Obvious-Type Double Patenting

The Examiner further rejected claims 23-73 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of United States Patent No. 6,582,442. In order to avoid further expenses and time delay, Applicants elect to expedite the prosecution of the present application by filing a terminal disclaimer to obviate the double patenting rejection in compliance with 37 C.F.R. § 1.321 (b) and (c). Applicant's filing of the terminal disclaimer should not be construed as acquiescence of the Examiner's double patenting or obviousness-type double patenting rejections. Attached is the terminal disclaimer and accompanying fee.

CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 22nd day of October, 2004.

Respectfully submitted,



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